

Amendment
Serial No. 08/801,458
Page 6

prosecution. Claims 10, 20, and 23 are herein canceled without prejudice. Claims 2-7, 9, 11, 13-19, 21, and 24-26 have been amended to more clearly claim the invention. No new matter has been added. Claims 2-9, 11-19, 21, 22, and 24-26 are now pending in the application.

Applicants thank Examiner Meky and Examiner Titcomb for the courtesy of the on-site interview at the Patent and Trademark Office on April 29, 1999. In view of the interview summary produced at the interview and the above amendments, Applicants respectfully request reconsideration of the pending claims.

Rejection of Claims 2-26 under 35 U.S.C. §102(e)

Claims 2-26 stand rejected under 35 U.S.C. § 102(e) as unpatentable over Collins et al. (US Patent No. 5,845,090). Applicant respectfully submits that as amended the claims overcome the basis of the rejection.

As amended, representative claim 15 of the Applicant's invention recites, in part, a system for delivering content to a client system. The system includes a service provider and software transmitted to the client system from the service provider. The software ascertains infrastructure-related information regarding the client system when the client system executes the software. The service provider selects content to transmit to the client system in response to the configuration of the client system as indicated by the infrastructure-related information. For example, the specification describes an exemplary embodiment in which the service provider determines whether to send 8 megabytes of data to a client based upon the hard disk space of that client (pg. 5, lns. 24-31). In another exemplary embodiment, the service provider determines whether to transmit multimedia to clients based upon the CPU power of those clients (pg. 8, lns. 25-34).

Collins discloses a software distribution system including a network manager server (NMS) that delivers "software packages" to target systems. One type of delivered package is a Collection package. When a target system receives and executes the Collection package, the package collects information that can be transmitted back to the NMS (col. 4, lines 18-29).

Amendment
Serial No. 08/801,458
Page 7

However, although showing a technique for collecting information at a target system and transmitting the information to another system, Collins does not disclose any use for such collected information by the network server. Consequently, Collins does not teach or suggest a service provider selecting content to transmit to the client system in response to the configuration of the client system as indicated by infrastructure-related information, as now set forth in Applicant's claimed invention. Therefore, Collins' collection packages and collected information do not teach or suggest the Applicant's claimed invention.

Furthermore, although Collins discloses a criteria-based technique for the limited customization of software packages based on criteria supplied by a target system (col. 8, lines 22-38), this technique is not what the Applicants' claim. Unlike the Applicant's invention, this criteria supplied by the target system is not information collected by software provided by the service provider. Moreover, in the Applicant's invention, the service provider selects the content to transmit to the client system according to the infrastructure-related information, whereas in Collins, a "Transfer Daemon" of the target system modifies the software package (see col. 6, lines 51-57 together with Fig. 2). Therefore, the system responsible for selecting the content to transmit in response to ascertained information is not the same in Collins as in the Applicant's invention. Therefore, Collins does not disclose every element of the Applicant's claimed invention as amended.

Applicant also submits that Collins does not suggest Applicant's claimed invention as amended. In a software distribution system, such as Collins, the process of distributing software is simpler when the content of the software packages is standardized. Conversely, customizing each software package for each target system would complicate the process. Therefore, modifying Collins so as to have the NMS server select the content to be transmitted in response to collected information would be contrary to Collins' express purpose "[t]o avoid requiring a different package for each possible configuration." (col. 8, lines 27-28). By this express purpose, then, Collins does not teach or suggest the Applicant's invention, but instead teaches away from it.

Amendment
Serial No. 08/801,458
Page 8

Rejection of Claims 2-26 under 35 U.S.C. §102(e)

Claims 2-26 stand rejected under 35 U.S.C. § 102(e) as unpatentable over Johnson et al. (US Patent No. 5,878,384). Applicant respectfully submits that as amended the claims overcome the basis of the rejection.

Johnson discloses an information monitoring system that employs a software infiltration technique to collect information. The technique inserts a stub program between an application program executing on a user's system and the application program interface (API) routines called by that program. The stub program intercepts information conveyed between the program and the API and stores the collected information for subsequent transmission to a server. Collection of information focuses entirely on the activities of that application program.

However, other than to indicate that the information is sent to the server, Johnson is silent as to how the server responds to the collected information. In this respect, Johnson is similar to Collins. While the collected information may be used for marketing products and services to a user of the target system, Johnson does not disclose any such use of the collected information by the server. Johnson, then, does not disclose the Applicant's invention, wherein a service provider selects, in response to the configuration of the client system, content to transmit to the client as now set forth in the Applicant's claimed invention.

Moreover, Johnson's software infiltration technique cannot teach or suggest Applicant's claimed invention. While Johnson's stub program may be useful for intercepting communications between an application program and a communication service, this infiltration technique is unsuited, and even unnecessary, for determining infrastructure-related information regarding a client system, such as that described in the Applicant's specification on at least page 7. Further, modifying such a stub program to collect such infrastructure-related information would necessarily change Johnson's principle of operation. Therefore Johnson cannot suggest the Applicant's claimed invention.

Amendment
Serial No. 08/801,458
Page 9

Lastly, in view of the amendment to claim 15, Applicant respectfully submits that Filepp (U.S. Patent No. 5,758,072) neither discloses nor suggests Applicant's claimed invention as amended.

Filepp discloses an interactive computer network that collects information related to a reception system's activities, such as types of informational services accessed, transactions processed, elapsed time between events (col. 88, lines 28-31), but not information related to the reception system's infrastructure. Unlike the applicant's claimed invention, Filepp's network server does not select advertising objects to send to the reception system based upon the configuration of the reception system as indicated by collected infrastructure-related information.

Moreover, Filepp provides no motivation to select advertising objects upon the basis set forth in Applicant's claims. Typically, advertising content is based upon a user's tastes, not upon the configuration of that user's system. Modifying Filepp so that the network server determines those advertising objects to send to the reception system based upon the configuration of the reception system would change the basis upon which Filepp selects content to send to the reception system. Because such hypothetical modification would alter Filepp's underlying principles of operation, the use of Filepp as a 103 reference is improper. MPEP § 2143.02.

Applicant therefore submits that claims 2-9, 11-19, 21, 22, and 24-26 are allowable as amended and respectfully requests early favorable action by the Examiner.

If the Examiner believes that a telephone conversation with Applicant's agent would expedite prosecution of this application, the Examiner is cordially invited to call the undersigned agent of record.

Dated: 5/21/99

Tel.: 617/248-7738
Fax.: 617/248-7100
TURANO2115/4.797671-1

Respectfully submitted,



Thomas A. Turano
Registration No. 35,722
Agent for Applicants
TESTA, HURWITZ, & THIBEAULT, LLP
High Street Tower
125 High Street
Boston, MA 02110